

TO:	Mail Stop 8	SOLICITOR	2007	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
	Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	AUG 17		
U.S. PATENT & TRADEMARK OFFICE				

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
filed in the U.S. District Court Eastern District of Kentucky on the following ☐ Patents or ☒ Trademarks:

DOCKET NO. 5:01-cv-237-JMH	DATE FILED 6/4/2001	U.S. DISTRICT COURT Eastern District of Kentucky, Central Division at Lexington
PLAINTIFF Lexmark International, Inc.; Pitney-Bowes, Inc. (Plaintiff in consolidated cases 02-63 & 02-100)		DEFENDANT Pitney-Bowes, Inc.; Apple Computer et al (defendants in consolidated case 02-63); Xerox Corporation et al (defendants in consolidated case 02-100)
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 4,386,272	5/31/1983	Pitney Bowes Inc.
2 4,809,021	Not provided	Pitney Bowes Inc.
3		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT Stipulation and Order of Dismissal filed 5/28/2004 - dismissed
--

CLERK Leslie G. Whitmer	(BY) DEPUTY CLERK Michelle W. Zegafuse <i>MZ</i>	DATE 8/15/2007
----------------------------	--	-------------------

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

195

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF KENTUCKY

JUN 4 2001

AT LEXINGTON
LESLIE G. WHITMER
CLERK U.S. DISTRICT COURT

LEXMARK INTERNATIONAL, INC.,

Plaintiff,

v.

PITNEY-BOWES, INC.,

Defendant.

Civil Action No. 01-237

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff, Lexmark International, Inc. ("Lexmark"), by its attorneys, and for its Complaint against Defendant, Pitney-Bowes, Inc. ("Pitney-Bowes"), alleges as follows:

1. Plaintiff, Lexmark, a Delaware corporation, has its principal place of business at 740 New Circle Road NW, Lexington, Kentucky.

2. Defendant, Pitney-Bowes, is a Delaware corporation has a principal place of business at One Elmcroft Road in Stamford, Connecticut.

3. Lexmark seeks a declaratory judgment pursuant to Title 28, UNITED STATES CODE §§ 2201 and 2202 with respect to a controversy between the parties regarding the non-infringement by Lexmark of Pitney-Bowes' U.S. Patent Nos. 4,386,272 ("the '272 patent") and 4,809,021 ("the '021 patent") and regarding the invalidity of these patents.

4. This Court has subject matter jurisdiction pursuant to the Federal Declaratory Judgment Act, Title 28, UNITED STATES CODE, §§ 2201 and 2202, over the

I certify that this is a true and correct
copy of the original filed in my office
LESLIE G. WHITMER, CLERK
By [Signature]
Date 6-15-2001 Deputy Clerk

controversy of this Complaint which arises under the laws of the United States concerning actions relating to patents, 28 UNITED STATES CODE § 1338(a).

5. Venue in this Judicial District is proper under 28 UNITED STATES CODE § 1391.

6. Upon information and belief, Pitney-Bowes is the owner of record of the '272 patent and the '021 patent .

7. The '272 patent and the '021 patent relate to alleged improvements in laser printing systems and methods.

8. Lexmark markets in the United States laser printing systems which do not utilize the improvements which are subject of Pitney-Bowes '272 and '021 patents.

9. Pitney-Bowes has charged Lexmark with infringement of the '272 patent and has alleged infringement of the '021 patent.

10. Lexmark has not infringed any claim of the '272 patent or the '021 patent; however, as the result of the charges and allegations of infringement, Lexmark has a reasonable apprehension that Pitney-Bowes may sue Lexmark for infringement of the '272 patent and the '021 patent.

11. Pitney-Bowes has asserted that the '272 patent and the '021 patent are valid.

12. Lexmark believes that the '272 patent and the '021 patent are invalid under statutory and decisional law, for failing to satisfy one or more requirements for patentability set forth in Title 35, Part II, UNITED STATES CODE and the rules, regulations, and law pertaining thereto, including, *inter alia*, the requirements of one or more of the provisions of 35 U.S.C. § 101, § 102, § 103, § 112, and § 120.

13. There is therefore an actual present justiciable controversy as to the validity of the '272 patent and the '021 patent and as to infringement of these patents by Lexmark.

WHEREFORE, Plaintiff Lexmark requests an entry of judgment and relief against Pitney-Bowes:

- A. declaring that Lexmark does not infringe the '272 patent and the '021 patent;
 - B. declaring that the '272 patent and the '021 patent are invalid;
 - C. awarding of costs, expenses, and reasonable attorneys' fees to Lexmark;
- and
- D. awarding such other and further relief at this Court may deem just and proper.


DEMAND FOR A JURY TRIAL

Plaintiff hereby demands a trial by jury as to all issues triable by a jury.

Respectfully submitted,

STOLL, KEENON & PARK

June 4, 2001

By: 

William L. Montague, Jr.
STOLL, KEENON & PARK
201 E. Main Street
Suite 1000
Lexington, Kentucky 40507-1380
Telephone: (859) 231-3946
Fax: (859) 253-1093

Of Counsel:

Stephen G. Rudisill
Steve Z. Szczepanski
JENKENS & GILCHRIST
225 W. Washington St.
Suite 2600
Chicago, Illinois 60606-3418
Telephone: (312) 425-3900
Fax: (312) 425-3909

Attorneys for the Plaintiff,
LEXMARK INTERNATIONAL, INC.

EXHIBIT A

Eastern District of Kentucky
FILED

MAY 28 2004

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF KENTUCKY
LEXINGTON

AT LEXINGTON
LESLIE G. WHITMER
CLERK U.S. DISTRICT COURT

LEXMARK INTERNATIONAL INC.,

Plaintiff,

vs.

PITNEY BOWES INC.,

Defendant.

CIVIL ACTION NOS.

01-237-JMH and
02-63-JMH

I. STIPULATION AND ORDER OF DISMISSAL

IT IS HEREBY STIPULATED by and between the undersigned counsel for the parties that pursuant to Rule 41(a)(1)(ii) of the Federal Rules of Procedure, all claims that were asserted or could have been asserted in the above captioned Action by Defendants/Counter-Defendants Pitney Bowes Inc. ("PB") against Plaintiffs/Counter-Plaintiffs Lexmark International, Inc. ("LEXMARK"), and all compulsory counterclaims that were asserted or could have been asserted in this Action by LEXMARK against PB, shall be and hereby are dismissed with prejudice and forever barred, with each party foregoing any right of appeal. Each party shall bear its own costs.

Entered this 28th day of May, 2004.

Joseph M. Hood
Judge Joseph M. Hood
United States District Court

I certify that this is a true and correct
copy of the original filed in my office
LESLIE G. WHITMER, CLERK
Date 5-15-2004 Deputy Clerk

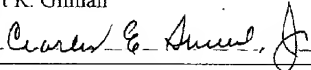
EXHIBIT A

Submitted by:

STOLL, KEENON & PARK, LLP
Charles E. Shivel, Jr.
Steven B. Loy
Hanly A. Ingram

MINTZ, LEVIN, COHN, FERRIS GLOVSKY &
POPEO PC
Paul J. Hayes
Eugene A. Feher
Robert R. Gilman

by:

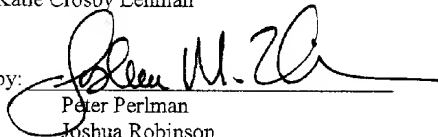


Charles E. Shivel, Jr.
Attorneys for Plaintiffs/Counter-Plaintiffs
LEXMARK INTERNATIONAL, INC.

PETER PERLMAN LAW OFFICES
Peter Perlman
Joshua Robinson
388 South Broadway
Lexington, KY 40508

ROBINS KAPLAN, MILLER & CIRESI
Michael V. Ciresi
Jan M. Conlin
Katie Crosby Lehman

by:



Peter Perlman
Joshua Robinson
Attorneys for Defendant/Counter-Defendant
PITNEY BOWES INC.